

REMARKS

In the April 29, 2005 Office Action, the Examiner noted that claims 1-11 were pending in the application; objected to claims 2-11; and rejected claims 1-11 under 35 USC § 103(a). In rejecting the claims, U.S. Patent 5,608,611 to Szudarek et al. and U.S. Patent Application Publication No. 2002/0155738 by Ohsawa et al. (References F and H, respectively) was cited. Claims 1-11 remain in the case. The Examiner's rejections are traversed below.

Objection to Title

In item 1 on page 2 of the Office Action, the Examiner objected to the title as "not descriptive." The title has been amended as suggested by the Examiner. Withdrawal of this objection is respectfully requested.

Objection to Claims

In item 2 on page 2 of the Office Action, the Examiner objected to claims 2-11 for using "An assembly" instead of "The assembly" in the preamble. No support for this objection was provided. The Examiner's attention is directed to U.S. Patents 6,765,441; 6,855,563; and 6,900,005, which are a few of the many thousands of issued patents that use the indefinite article instead of the definite article in the preamble of dependent claims (note that 6,900,005 uses both). Withdrawal of this objection is respectfully requested.

The Examiner also objected to claim 10 and proposed modifying the description of the operation of the conductive fastening element from "while conducting with said conductor" to --while brought into conductive contact with said conductor--. Since the fastening element is always fastened when the assembly is assembled, the original language seems more appropriate. Therefore, no change has been made and withdrawal of the objection is respectfully requested.

If the Examiner rejects these requests to withdraw the objections to the claims, the Examiner is respectfully requested to contact the undersigned by telephone to arrange an Examiner Interview prior to the next Office Action, so that the reasons of these objections can be explained and appropriate amendment of the claims can be expedited.

Rejections under 35 U.S.C. § 103(a)

In item 4 on pages 3-4 of the Office Action, the Examiner rejected claims 1-11 under 35 U.S.C. § 103(a) as unpatentable over Szudarek et al. in view of Ohsawa et al. In rejecting the

claims, the Examiner acknowledged that Szudarek et al. did not disclose "the output signal cable having a shield member that is connected to the conductor 16 of the circuit board 10" (Office Action, page 3, lines 12-14) or "electronic module 39 to be an encoder" (Office Action, page 3, line 14). Furthermore reference numeral 36 was inaccurately described in the Office Action as a "motor housing," while in Szudarek et al. it is referred to as "metal portion 36 of the vehicle" (column 3, line 17), "preferably a portion of the vehicle frame/body" (column 3, lines 19-20). Furthermore, reference numeral 12 which the Examiner described as a "board connector" (Office Action, page 3, line 6) is referred to in Szudarek et al. as a "connector module" (e.g., column 2, line 39) in which "[a]t least one of the pins on the connector module 12 serves the purpose of providing an electrical path to ground for the electrical components connected to the connector module 12" (column 2, lines 42-45), i.e., "ground pin 24" (e.g., column 2, line 49).

Thus, in addition to not disclosing a shielded output signal cable or an encoder, Szudarek et al. does not disclose a motor housing either. In other words, three of the four elements of claim 1 are not disclosed by the "primary" reference. Since the secondary reference, Ohsawa et al., discloses only one of the remaining two elements, half of the elements of claim 1 are not disclosed in the references used to reject the claims. Without any acknowledgment that there are similarities between the grounding mechanisms recited in claim 1 and what is taught by Szudarek et al., it is submitted that the Examiner has failed to provide a *prima facie* case of obviousness by failing to cite references that disclose what is recited in the claims. Claim 1 is directed to "[a]n assembly of electric motor with encoder" and recites each of these as elements of the claim. Neither of the cited references disclose either of these elements. It is improper to ignore the subject matter of the claim as recited in the preamble, particularly when the body of the claim includes the same subject matter, and rely on mere differences in "the electronic components inside the module" (Office Action, page 3, line 15).

For the reasons set forth above, it is respectfully submitted that the April 29, 2005 Office Action must be withdrawn and a new non-final Office Action issued citing references that disclose all of the elements recited in the claims.

Summary

It is submitted that the references cited by the Examiner, taken individually or in combination, do not teach or suggest the features of the present claimed invention. Thus, it is submitted that claims 1-11 are in a condition suitable for allowance. Entry of the Amendment, reconsideration of the claims and an early Notice of Allowance are earnestly solicited.

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Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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